

IN RE URBANSKI, Appeal No. 2015-1272 (Fed. Cir. January 8, 2016). Before Lourie, Bryson, and Chen. Appealed from the Patent Trial and Appeal Board.

Background:

An applicant claimed a method for making an enzymatic hydrolysate of a soy fiber. The method included a step of mixing water, soy fiber, and enzymes for about 60 minutes to about 120 minutes to eventually produce a soy fiber with a specific degree of hydrolysis, water holding capacity, and free simple sugar content.

The Examiner rejected the claims as having been obvious over references that disclose methods of enzymatic hydrolysis of dietary fibers. The primary reference taught that a longer hydrolysis time (5 or more hours) produces a more stable product, while the secondary reference taught that a shorter hydrolysis time (100 to 240 minutes) produces a soy fiber with improved sensory properties. The Examiner found that the degree of hydrolysis of the fiber was a result-effective variable and that one of ordinary skill in the art would have expected that reducing the reaction time would result in the claimed water holding capacity and free simple sugar content.

The applicant argued that the primary reference taught away from reducing the hydrolysis time because a shortened hydrolysis time would render the method unsatisfactory for its intended purpose in producing stable dispersions. The Examiner found this argument unpersuasive, and the applicant appealed to the PTAB.

The PTAB held that although the benefits of the prior art processes were "mutually exclusive," the fact that one benefit may come at the expense of the other did not outweigh the evidence of obviousness, and affirmed the Examiner's rejection. The applicant appealed to the Federal Circuit.

Issue/Holding:

Did the PTAB err in affirming the Examiner's obviousness rejection? No, affirmed.

Discussion:

The Federal Circuit held that the primary reference's disclosed benefit of a longer reaction time did not rise to the level of "teaching away" from a shorter reaction time. The court noted that a reference teaches away only when a person of ordinary skill would be led in a different direction than the path that was taken by the applicant. This was not the case here because the primary reference did not criticize or discredit shorter reaction times. Instead, the reference described only the benefits of a longer reaction time. Additionally, because the proposed modification would not render the method inoperative, the court held that one of ordinary skill in the art would have been motivated to pursue the desirable properties taught by the secondary reference, even at the expense of foregoing the benefit taught by the primary reference. Thus, the Federal Circuit held that the PTAB did not err in affirming the Examiner's obviousness rejection.